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09/758,127	01/12/2001	Chun-un Kang	Q61464	8900

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EXAMINER

DANG, KHANH

ART UNIT PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/758,127
Filing Date: January 12, 2001
Appellant(s): KANG ET AL.

MAILED

NOV 30 2004

Technology Center 2100

Cameron W. Beddard
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/12/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

n/a

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6609167	Bastiani et al.	8-2003
6199122	Kobayashi	3-2001
6601056	Kagle et al.	7-2003
6408350	Kawamura et al.	6-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 92 and 94 are rejected under 35 U.S.C. 102(e) as being anticipated by Bastiani et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any step that differs from Bastiani et al. With regard to claims 92 and 94, Kawamura discloses an operation method of a portable personal device having facilities for storing and playing digital contents by control from a computer (host) through a serial or parallel cable, the method comprising the steps of: (a) receiving a request command from the computer (host) through a serial or parallel cable (from host to device through ASP); (b) sending from the portable personal device (ASP device) through a serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer (host), when the portable personal device (ASP device) is ready to execute the request command (ACK is now sent from device to host); (c) receiving an execution command (next packet is sent in response to ACK) from the computer (host) through a serial or parallel cable for executing the request command received in the step (a); and (d) executing the request command, when the execution command is received in the step (c), and then sending the result to the computer through a serial or parallel cable (ACK/status after the request executed without any error).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi et al.

Bastiani et al., as explained above, discloses the claimed invention. However, Bastiani et al. does not disclose the use of a format conversion step to convert for facilitating interconnecting devices having different formats. Kobayashi et al. discloses the use of a format conversion for facilitating interconnecting devices having different formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a format conversion, as taught by Kobayashi et al., for the purpose of facilitating/enhancing the interconnectivity of Bastiani et al. with other devices having different formats. Note also that "packets" in Bastiani et al., as in any other conventional packets, include indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data. If the Applicants choose to challenge the fact that a "packets" includes indicators for indicating a begin and end of data, length

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of data, start and content of command or status, and an indicator indicating an end of a transmission data, supportive documents will be provided upon request.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kawamura et al.

Bastiani et al., as explained above, discloses the claimed invention. However, Bastiani et al. does not disclose the use of a format conversion step to convert for facilitating interconnecting devices having different formats. Kawamura et al. discloses the use of a format conversion for facilitating interconnecting devices having different formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a format conversion, as taught by Kawamura et al., for the purpose of facilitating/enhancing the interconnectivity of Bastiani et al. with other devices having different formats. Note also that "packets" in Bastiani et al., as in any other conventional packets, include indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data. If the Applicants choose to challenge the fact that a "packets" includes indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data, supportive documents will be provided upon request.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kagle et al.

Bastiani et al., as explained above, discloses the claimed invention. However, Bastiani et al. does not disclose the use of a format conversion step to convert for facilitating interconnecting devices having different formats. Kagle et al. discloses the use of a format conversion for facilitating interconnecting devices having different formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a format conversion, as taught by Kagle et al., for the purpose of facilitating/enhancing the interconnectivity of Bastiani et al. with other devices having different formats. Note also that "packets" in Bastiani et al., as in any other conventional packets, include indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data. If the Applicants choose to challenge the fact that a "packets" includes indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data, supportive document(s) will be provided upon request.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi et al., as applied to claims 1 and 2 above, and further in view of the following.

The further difference between the claimed subject matter and that of Bastiani et al. is the use of a docking station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a docking station, since the Examiner takes Official Notice that the use of a docking station is old

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and well-known; and providing one to Bastiani et al. for the purpose of expanding the connecting capability of the device of Bastiani et al. to a plurality of peripherals only involves ordinary skill in the art. If the Applicants choose to challenge the fact that a "docking station" is old and well-known, supportive document(s) will be provided upon request.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kawamura et al., as applied to claims 1 and 2 above, and further in view of the following.

The further difference between the claimed subject matter and that of Bastiani et al. is the use of a docking station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a docking station, since the Examiner takes Official Notice that the use of a docking station is old and well-known; and providing one to Bastiani et al. for the purpose of expanding the connecting capability of the device of Bastiani et al. to a plurality of peripherals only involves ordinary skill in the art. If the Applicants choose to challenge the fact that a "docking station" is old and well-known, supportive document(s) will be provided upon request.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kagle et al., as applied to claims 1 and 2 above, and further in view of the following.

The further difference between the claimed subject matter and that of Bastiani et al. is the use of a docking station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a docking station, since the Examiner takes Official Notice that the use of a docking station is old and well-known; and providing one to Bastiani et al. for the purpose of expanding the connecting capability of the device of Bastiani et al. to a plurality of peripherals only involves ordinary skill in the art. If the Applicants choose to challenge the fact that a "docking station" is old and well-known, supportive document(s) will be provided upon request.

(11) Response to Argument

Background for Examiner's Response:

Relevant Law:

Claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003).

Claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Bastiani et al. 102(e) Rejection :

With regard to claim 92, Appellants argue that "Bastiani et al. do not disclose sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal device is ready to execute the request command." Appellants further argue that "[a]lthough Bastiani et al. discloses that a device responds to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read, Appellants submit that the response of the device of Bastiani et al. does not correspond to a signal indicating that the portable personal device is ready to execute the request command. The device responds to the HEARTBEAT packet with an ACK packet, which indicates that the device is ready." Appellants submit that 'ready' in Bastiani does not correspond to 'ready to execute the request command' as recited in the claim.'" Appellants then concludes that "[r]ather, the HEARTBEAT packet is used to determine whether a device is able to receive any data."

In response to Appellants' argument, it is first acknowledged that Appellants concede that "the HEARTBEAT packet is used to determine whether a device is able to receive any data." It is clear that "any data" includes the "request command," since "request command" is a form of data. In any event, in Bastiani, after responding to the HEARTBEAT packet with an ACK indicating that the device is ready (see at least column 43, lines 30-34), the host will send the device a request command. ACK in the case of HEARBEAT indicates that the device is powered and able to receive link or device commands from the host (see at least column 31, line 67 to column 32, line 2). Further, Bastiani et al. discloses that once the host has determined that a device is attached and ready, the host requests configuration information from the device to determine the device's capabilities (see at least column 36, line 61 to column 37, line 5).

With regard to claim 94, Appellants argue that "[a]s described above in the arguments for claim 92, Bastiani et al. fails to teach or suggest sending from a portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to execute a request command to a computer, when the portable personal device is ready to execute the request command. Since the reference does not disclose sending the above-recited signal, the reference must also fail to disclose receiving the signal. Thus, claim 94 is not anticipated by Bastiani et al."

In response to Appellants' argument, Bastiani et al., as discussed above regarding claim 92, does disclose "sending" a HEARTBEAT signal, and it is clear that such signal is received by the host.

The 103 Rejections:

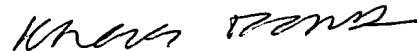
With regard to claims 1-3, Appellants argue that “[c]laim 1 of the present invention recites sending from the portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to the computer, when the portable personal device is ready to format. In the rejection of claim 1, the Examiner refers to the rejection of claims 92 and 94 in asserting that this feature of claim 1 is disclosed by Bastiani et al. Appellants submit that Bastiani et al. does not disclose this feature of the claim for reasons analogous to those presented above for claim 92. Furthermore, Kobayashi, Kawamura et al., Kagle et al. and the Examiner's taking of Official Notice fail to make up for the deficiencies of Bastiani et al. Therefore, claim 1 and its dependent claims 2 and 3 are allowable over the prior art.”

In response to Appellants' argument, it is first noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As explained above, the combination of Bastiani et al. and either Kobayashi, Kawamura et al., Kagle et al., or the Examiner's taking of Official Notice discloses “sending from the portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to the computer, when the portable personal device is ready to format.”

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



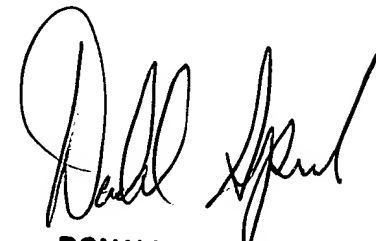
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